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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,678	01/18/2002	Y. Tom Tang	PF-0595 USN	7571

7590 04/08/2004
Incyte Genomics Inc
Legal Department
3160 Porter Drive
Palo Alto, CA 94304

EXAMINER

SCHNIZER, HOLLY G

ART UNIT PAPER NUMBER

1653

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,678

Applicant(s)

TANG ET AL.

Examiner

Holly Schnizer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-2 and 15, drawn to a polypeptide comprising a sequence selected from the group consisting of SEQ ID NOs: 1-6 and fragments thereof.

Group II, claim(s) 3-4, 9-10, and 13-14, drawn to a polynucleotide encoding the polypeptide.

Group III, claim(s) 5-6 and 11, drawn to polynucleotides that are complementary or that hybridize to a polynucleotide encoding one of SEQ ID NOs: 1-6.

Group IV, claim(s) 7-8, drawn to hybridization assays.

Group V, claim(s) 16, drawn to an antibody that specifically binds the polypeptide.

Group VI, claim(s) 17, drawn to an agonist of the polypeptide.

Group VII, claim(s) 18, drawn to an antagonist of the polypeptide.

Group VIII, claim(s) 19, drawn to a method of treating or preventing a disorder associated with decreased expression of HCHP.

Group IX, claim(s) 20, drawn to a method of treating or preventing a disorder associated with increased expression of HCHP.

In addition, the individual proteins of Group I are distinct and are not so linked as to form a single general inventive concept under PCT Rule 13.1. The polypeptides comprising SEQ ID NOs: 1-6 have different lengths, sequences, structures, and functions. Moreover, they were isolated from different tissues. For example, the protein of SEQ ID NO:3 appears to have been isolated from pulmonary artery and has sequence homology to mt-GrpE#2 precursor, a mitochondrial protein that regulates the ability of DnaK to bind and stabilize unfolded proteins before their release; whereas, the protein

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of SEQ ID NO:4 was isolated from adrenal tissue and appears to be related to hsp40, a protein that regulates hsp70 dependent folding. Thus, the proteins have different structures, are expressed in different tissues, and interact with completely different proteins. The patentability of each of the claimed proteins would be independent of the patentability of the others. Thus, upon the election of one of the above Groups, Applicants must elect a single protein sequence (or polynucleotide encoding it or its complement, etc.) to be examined.

The inventions listed in Groups I-IX do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking groups I-IX appears to be that they all relate to the polypeptide claimed in Group I. In the present case, the main invention (the first invention of the category first mentioned in the claims) is the protein of SEQ ID NO:1.

However, Bauer et al. (J. Mol. Biol. (May 1999) 289: 69-82) discloses a protein having the sequence of SEQ ID NO :1 (hTim44) (see p. 77, Fig. 8A and figure legend and sequence alignment attached to this Restriction Requirement). Bauer et al. teaches that the hTim44 protein was applied to a gel filtration column, eluted, and analyzed by SDS-PAGE, thus the protein disclosed in Bauer et al. is considered "substantially purified".

Therefore, the technical feature linking the inventions of Groups I-IX does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art.

A telephone restriction requirement was not made in this application due to an explicit request by Incyte and their policy of not making elections in response to telephonic restriction requirements

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim


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remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Schnizer whose telephone number is (571) 272-0958. The examiner can normally be reached on Tuesday, Thursday, and Friday from 8 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571) 272-0951. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Holly Schnizer
April 5, 2004


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SUPERVISORY PATENT EXAMINER
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